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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,536	02/21/2002	Walter A. Nichols	021238-513	4135

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/078,536

Applicant(s)

NICHOLS ET AL.

Examiner

Dionne A. Walls

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-40 and 43-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-40 and 43-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11<sup>th</sup>, 2003 has been entered.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 26-40 and 43-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of Nichols et al (U.S. Patent No. 6,367,481) in view of Adams et al (US. Pat. No. 4,784,164).

Nichols et al claims all that is recited in the instant claims, except it may not state that the thermally opened perforations are blocked with occlusions which comprise

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combustible filling material. However, Adams et al discloses that it is known to partially or fully block perforations by a coating of heat-removable composition (corresponding to the claimed "combustible filling material") (see col. 1, lines 46-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the composition disclosed as being known in Adams et al to fill the perforations of the wrapper claimed in Nichols et al in order to allow the perforations to be opened by the approach of the burning tip so as to reduce porosity of the wrapper during smoking – as is well-known in the art.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-34,37-40,43-48,50 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bale et al (US. Pat. No. 4,832,057) in view of Adams et al (US. Pat. No. 4,784,164).

Bale et al teaches a smoking article having a smoking material (Fig. 15, ref. No. 18); a first layer of combustible material formed around the smoking material (Fig. 15, ref. No. 19); a second layer of combustible material formed around the first layer where the second layer reduces combustion of the first layer and the first layer is more combustible than the second layer (Fig. 15, ref. No. 22 and 10 and col. 9, lines 4-12).

While Bale et al may not teach that the second layer includes perforations that are

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"thermally opened" by being blocked with occlusions that comprise combustible filling material. Adams et al discloses that it is known to partially or fully block perforations by a coating of heat-removable composition (corresponding to the claimed "combustible filling material"). It further states that these perforations may be of any shape (corresponding to the claimed "square perforations"), and materials used to block the perforations can be cellulose compounds (corresponding to the claimed "cellulosic materials")(see col. 1, lines 46-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the composition disclosed as being known in Adams et al to fill the perforations of the wrapper claimed in Nichols et al in order to allow the perforations to be opened by the approach of the burning tip so as to reduce porosity of the wrapper during smoking – as is well-known in the art.

Bale et al also teaches the smoking material is tobacco based material (col. 5, line 63)

Bale et al also teaches the second layer comprises a composite layer containing multiple layers, including a metal foil layer and one or two paper layers (col. 9, lines 4-12).

Bale et al also teaches that the second layer extends to the distal end of the article at which the smoking article is exposed (Fig. 8, ref. No. 22,10).

Bale et al also teaches that the second layer has perforations (col. 9, lines 4-9).

Bale et al also teaches that the perforations are blocked by the first layer of material before use of the article (Fig. 15, ref. No. 19,22,10; col. 9, lines 4-9).

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Bale et al also teaches that the perforations are arranged in a pattern (col. 9, lines 4-9. Note: Any combination of holes would be a pattern)

Bale et al teaches that the perforations are blocked by the first layer of material before smoking of the cigarette.

6. Claims 35-36, 49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bale et al (US. Pat. No. 4,832,057) in view of Adams et al (US. Pat. No. 4,784,164) as applied to claim the claims above, and further in view of Riggs et al (US. Pat. No. 5,551,451) and Blakley (US. Pat. No. 5,360,023).

Bale et al modified by Adams et al substantially teaches Applicant's claimed invention, except for the second layer extending 1mm – 5mm from the distal end, the perforations having different sizes, and the smaller perforations located closer to the distal end that the larger sized perforations may not be explicitly stated. Riggs et al teaches that the second layer extends to a non-zero distance L from the distal end of said article at which said smoking material is exposed (Fig. 1, ref. No. 16-18, as can be seen from drawing 17 which extends to and beyond the smoking material 16). It would have been obvious to combine Riggs et al's composite layer with Bale et al/Adams et al's smoking article because Bale et al teaches the use of aluminum foil and its similar materials (page 2-3, lines 24-30, 1-8). Thus, one having ordinary skill in the art would recognize the similarity and desirability of using a foil composite at a non-zero distance from the distal end of the cigarette.

Blakley et al teaches that the plurality of perforations are arranged in a pattern (Fig. 2, ref. No. 60, the perforations being arranged in lines). Blakley et al further

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teaches that "size, number and relative positioning of the individual perforations can vary depending on the desired characteristics". (col. 4, lines 20-25). Thus, Blakley et al's teaching as to the size, number and pattern makes Applicant's claims to the different sized holes and the positioning of the smaller holes closer to the distal end obvious in view of Blakley et al because at the distal end of the cigarette, where the end of the cigarette is exposed to the atmosphere, less air is needed to maintain the igniting element at a stable temperature and thus smaller holes would suffice. While, at further up the cigarette, larger holes would be required to maintain the heat because the aluminum foil of Riggs et al and Bale et al would be dissipating the heat from the ignition source. Finally, Blakley et al teaches that placing the smoking material into a smoking material section and the perforations at the base end (Fig. 1, ref. No. 20,60, the perforations extending all the way to the filter 32, which is the base end). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Blakley with Riggs et al because doing so would have provided a cigarette with more even burning characteristics and would permit the ignition of the device to be supplied with air and thus maintain a stable heat source that would be difficult to achieve without Blakley's teaching.

Moreover, Applicant's claim to the 1 – 5 mm range of extension for the second layer from the distal end is deemed obvious in view of Riggs et al's Fig. 1, ref. No. 14 and 17. It appears that the aluminum foil/paper element 17 extends up to and beyond the distal end of the tobacco material 16 but about one-third of the length of the fuel

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element 10, which according to Riggs et al is 12 mm (col. 11, line 1). Thus, the distance is about 4 mm and thus Applicant's range is rendered obvious.

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Blakley's patents of holes, and Riggs composite wrapper material spaced from the distal end of the cigarette with Bale et al/Adam et al's tobacco product because doing so would merely provide for more even combustion of the tobacco and permit the fuel element to maintain its proper temperature.

### ***Response to Arguments***

7. Applicant's arguments with respect to the existing claims have been considered but are moot in view of the new ground(s) of rejection which were necessitated based on the amendments to the claims.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Dionne A. Walls  
September 19<sup>th</sup>, 2003